REMARKS

Claims 10-18 are pending in the application. By the present amendment, claim 10 has been amended for clarity. Favorable reconsideration of the application in view of the remarks set forth herein is respectfully requested.

The rejection of claims 10 and 11 under 35 U.S.C. §103(a) over Schotz (U.S. Patent No. 5,832,024) in view of Lee (U.S. Patent No. 5,757,936) is respectfully traversed. Without acquiescing in the rejection, claim 10 has been amended for clarity. Accordingly, the rejection will be discussed with respect to the claims as amended.

Lee discloses a system that transmits audio signals over AC power lines. Lee's system converts an audio signal into a digital signal, converts the digital signal into an FM signal, transmits the FM signal over an AC power line, reconverts the FM signal into a digital signal and reconverts the digital signal into an audio signal. Lee references Schotz '570 as teaching a transfer technique. According to Lee, the stereo signals are converted into two separate FM signals by variable frequency oscillators operating a two different carrier frequencies (see, e.g., Col. 2, lines 58-61). Moreover, there is no teaching or suggestion anywhere in Lee of transmission of digital signals using data packets.

In complete contrast, the claimed invention specifically recites the use of data packets to transmit digital information, and that these packets are transmitted over AC power lines using one carrier frequency. There is no teaching or suggestion of this combination of features in either Schotz or Lee.

Schotz '024 is directed to a *wireless* speaker system. Schotz '024 teaches converting the audio input signal into a digital serial bit stream. There is no teaching or suggestion of using data packets to transmit digital information.

Accordingly, even if, *arguendo*, the combination of Lee and Schotz '024 were proper, the combination nevertheless fails to disclose, teach or suggest the use of data packets to transmit digital information over AC power lines using one carrier frequency.

Moreover, it is respectfully submitted that there is no motivation to combine Schotz '024 and Lee in the manner suggested in the Office Action. In particular, modifying Lee to use a one carrier frequency system would destroy the function of Lee in that Lee specifically requires that the channels be carried on two separate carrier frequencies.

It is also important to note that there is no objective motivation to combine Schotz '024 with Lee to arrive at the claimed invention. In particular, Schotz '024 is directed to a system that employs a modulator using Quadrature Phase Shift Keying (QPSK) for transmitting digital data to the loudspeakers. Lee, on the other hand, teaches the use of FM modulation which converts the stereo digital audio signals into two separate FM signals at two different carrier frequencies. It is respectfully submitted that there is no objective motivation in the art to combine features of a system employing QPSK with one that uses FM modulation. These two techniques are entirely inapplicable to one another. As such, one of ordinary skill in the art would not look to FM modulation art to

overcome a deficiency in a system employing QPSK, and likewise, one would not look to QPSK art to overcome a problem in an FM modulation system.

It is also respectfully submitted that employing techniques applicable to FM modulation in a QPSK system would destroy the function of the underlying reference. The same is the case when employing techniques applicable to QPSK systems in an FM modulation system – the combination would simply not work.

It is axiomatic that the PTO has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. See *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one or ordinary skill in the art would lead that individual to combine the relevant teachings of the references. See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). This it has not done. The Office Action fails to cite any prior art that overcomes the deficiencies of the base reference or that suggests the obviousness of modifying Schotz '024 to achieve the claimed invention.

Instead, the Office Action improperly relies on hindsight reconstruction of the claimed invention in reaching its obviousness conclusion. "To imbue one or ordinary skill in the art with knowledge of the invention, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." See *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1543, 220 USPQ 303,

312-13 (Fed. Cir. 1983). Additionally, further evidence of improper hindsight is derived from the absolute impermissible combination of disparate references in the instant rejection. In particular, there is an utter lack of any motivation whatsoever to combine the cited references to achieve the claimed invention. As set forth above, not only is there no motivation to combine the cited references, the proposed combination would destroy the function of the references themselves. Such a combination is *per se* improper.

In view of the foregoing, Applicant respectfully submits that Lee and Schotz '024 fail to establish a *prima facie* case of obviousness for any of the pending claims. Thus, without the improper use of hindsight reconstruction, using the teachings of the instant application, the claims are not rendered obvious under 35 U.S.C. §103. Moreover, the proposed combination nevertheless fails to achieve the claimed invention. In particular, there is no teaching or suggestion in either Lee or Schotz '024 of the use of data packets to transmit digital information over AC power lines using one carrier frequency. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

The rejection of claims 12, 13, 15 and 16 under 35 U.S.C. §103(a) over Schotz '024 in view of Lee and further in view of Anderson et al. (U.S. Patent No. 5,406,634, hereinafter "Anderson") is respectfully traversed.

It is respectfully submitted that Anderson fails to overcome the fundamental deficiencies noted above with respect to the improper combination of Schotz '024 and Lee. As such, the proposed combination (even if proper, which applicants submit is not

the case) of Anderson with the Schotz '024 and Lee nevertheless fails to render the claimed invention obvious. Moreover, Anderson specifically teaches the use of a TDM bus, *not* an AC network. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

The rejection of claim 14 under 35 U.S.C. §103(a) over Schotz '024 in view of Lee and further in view of Brugger (U.S. Patent No. 5,636,276) is respectfully traversed.

It is respectfully submitted that Brugger fails to overcome the fundamental deficiencies noted above with respect to the improper combination of Schotz '024 and Lee. As such, the proposed combination fails to render the claimed invention obvious. Moreover, Brugger teaches the use of an ATM communication network, *not* an AC power line network. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

In view of the foregoing it is respectfully submitted that the entire application is in condition for allowance. Favorable reconsideration of the application and prompt allowance of the claims are earnestly solicited.

Should the Examiner deem that further issues require resolution prior to allowance, the Examiner is invited to contact the undersigned attorney of record at the telephone number set forth below.

Respectfully submitted,

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Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on 3-9-04 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see *68 Fed. Reg. 38611*, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following item(s) is required. **Only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted.** 37 CFR 1.121(h).

THE FOLLOWING CHECKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
- ☐ B. New paragraph(s) should not be underlined.
- ☐ C. Other _____

☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
- ☐ B. Other _____

☐ 3. Amendments to the drawings: _____

☑ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
- ☐ B. The listing of claims does not include the text of all claims (including withdrawn claims)
- ☑ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.
- ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
- ☑ E. ~~Other~~: CLAIM 18 IS NOT A "NEW" CLAIM.

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf.

If the non-compliant amendment is a **PRELIMINARY AMENDMENT,** applicant is given ONE MONTH from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and **this ONE MONTH time limit is not extendable.**

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION (including a submission for an RCE),** and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a TIME PERIOD of ONE MONTH from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION,** this form may be an attachment to an Advisory Action. **The period for response to a final rejection continues to run from the date set in the final rejection,** and is not affected by the non-compliant status of the amendment.

Bobbie Davenport — 703-305-9630
Legal Instruments Examiner (LIE) — Telephone No.